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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/815,073

03/31/2004

Paul F. Mastro

A0867-US-DIV.

7348

25453

7590

06/17/2005

EXAMINER

HECKENBERG JR, DONALD H

PATENT DOCUMENTATION CENTER

XEROX CORPORATION

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ROCHESTER, NY 14644

ART UNIT

PAPER NUMBER

1722

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/815,073

Applicant(s)

MASTRO ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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1. The first line of the specification needs to be updated to reflect that the parent application, U.S. Pat. App. Ser. No. 09/794,131, has issues as U.S. Pat. No. 6,749,787.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagerty et al. (U.S. Pat. No. 4,747,864; previously made of record in the I.D.S. filed by Applicant) in view of Beesabathina et al. (U.S. Pat. No. 6,409,813; previously made of record in the I.D.S. filed by Applicant).

Hagerty discloses a molding apparatus for making glass articles. As noted described in Example III at cl. 11 - cl. 12, the apparatus includes an electroless nickel layer formed on a surface of a base (cl. 11, ll. 51-57). Further provided is a nitride layer is formed on the electroless nickel layer (cl. 11, l. 68 - cl. 12, l. 19).

Hagerty still further discloses the discloses first and second mold structures with the defined layers as insertable between first and second portions- specifically first and second

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press members (see cl. 9, ll. 30-39; cl. 11, ll. 21-41; and cl. 12, ll. 20-27).

While disclosing a nitride layer, specifically titanium nitride, Hagerty does not disclose a chromium nitride layer.

Beesabathina also discloses a molding apparatus for making glass articles. The apparatus includes a release coating, including as alternatives chromium nitride and titanium nitride (note in particular, cl. 5, ll. 45-49). Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the device disclosed by Hagerty as such to have used chromium nitride instead of titanium nitride because the two are known in the art as alternatives for use in molds as suggested by Beesabathina.

Hagerty further discloses in Example III of the reference the electroless nickel layer to have 5 mils (or, approximately 127 microns), and the titanium nitride layer to have a thickness of approximately 1 micron (see cl. 11, ll. 51-57, cl. 11, l. 67 - cl. 12, l. 19). Hagerty notes however, other ranges of thickness are possible for the nitride layer (cl. 8, l. 37-47). As indicated by the range of thicknesses disclosed by Hagerty, as well as the general nature of the mold, the exact thickness of layers is a operating parameter of the mold that would be optimized by one of ordinary skill in the art to

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achieve the best results. Note, the determination of optimum values of cause effective variables is generally see as within the skill of one practicing the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980); In re Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). Thus, in the instant case, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus disclosed and suggested by the combination of Hagerty and Beesabathina as such to have modified the thicknesses such as those recited in claims 6-14 because this would have optimized the apparatus for particular operating processes.

Claim 15 of the instant application recites that the "mold insert is insertable into a mold used to form a magnetic member from mold material." Written as such, this claim is merely reciting a use of the defined mold insert. It is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (CCPA 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963); MPEP § 2115. In the instant case, as the combination of Hagerty and Beesabathina disclose an apparatus with all of the structural features defined in claim 15 and there is nothing the references suggesting the at apparatus could not be used in a manner

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defined in claim 15, the combination of references anticipate these use limitations.

6. The following reference cited but not relied upon is deemed pertinent to the instant application:

Roffman et al. (U.S. Pat. No. 5,861,114) discloses a mold which includes electroless nickel insert (see cl. 32, ll. 9-20).

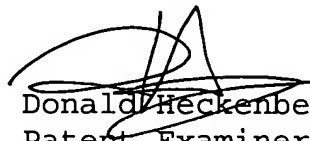
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith, can be reached at (571) 272-1166. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).


Donald Heckenberg
Patent Examiner
A.U. 1722

6-13-5